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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.,  
  
Plaintiff,  
  
v.  
  
GOOGLE INC.,  
  
Defendant.

Case No. CV 10-03561 WHA

**ORACLE'S RESPONSE TO GOOGLE'S  
SUPPLEMENTAL BRIEF RE:  
ORACLE'S MOTION IN LIMINE NO. 1**

During the April 14, 2016 hearing (“the Hearing”), Google argued that the parties reached an agreement related to interrogatory responses that justified Google’s failure to disclose its OpenJDK fair use arguments during fact discovery. Counsel for Google began to read a passage from meet-and-confer correspondence when the Court ordered Google to submit the parties’ discovery agreement in writing by 9 p.m. instead. Rather than do what the Court ordered, Google submitted a *six page* sur-reply to Oracle’s Motion that does not even address the Court’s request (the parties’ agreement) until page five. Even then, Google focusses on an e-mail exchange containing a proposal which does not fully memorialize the parties’ ultimate agreement. Google Supp. Br. at 5:4-14. Oracle will not respond to Google’s improper brief in kind except to say this: The three hour OpenJDK argument yesterday is but a small taste of the jury time that will be consumed if Google’s new OpenJDK arguments are permitted at trial. See ECF No. 1551 at 9.

\* \* \*

The agreement that the parties entered into relating to contention interrogatory responses did not excuse Google from presenting all bases for its fair use defense and did not permit Google to simply cite the entire case record, without any specificity. And in any event, none of Google’s new arguments are disclosed anywhere in the record or in the prior discovery.

During fact discovery, the parties reached a “no surprises” agreement regarding contention interrogatory responses. That agreement states that “the appropriate level of detail in interrogatory responses is that the parties *will state facts categorically*, and in that way provide the factual bases for their contentions.” ECF No. 1655-2 (11-2-15 e-mail from L. Simpson to B. Egan) (emphasis added); *see also* ECF No. 1655-3 (11-10-15 e-mail from L. Simpson to B. Egan) (confirming the November 2 agreement). The parties agreed that they could list categories of previously disclosed facts in support of new contention interrogatories, provided that those categorical statements are sufficient to disclose the parties’ respective theories.<sup>1</sup> *Id.* The parties’

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<sup>1</sup> As an example of a proper response, the following is an excerpt from Oracle’s First Supplemental Response to Google Interrogatory No. 21, served November 12, 2015:

The factual basis for a claim for recovery of Google’s profits attributable to the infringement also includes, for example: (1) the fact that Google has a business model for realizing substantial revenue from Android, including, at a minimum, revenue and gross profits from

1 agreement required that all new categories of information be disclosed in response to contention  
 2 interrogatories. ECF No. 1655-2 (“Oracle agrees that the parties are certainly entitled to  
 3 discovery of any newly learned factual bases supporting the parties’ respective contentions.”).

4 In October 2015, Oracle asked Google to supplement its prior response to an interrogatory  
 5 regarding fair use. Google’s counsel responded: “if Oracle seeks further information regarding  
 6 the basis for Google’s fair use defense, Oracle may serve a new interrogatory.” 11-1-2015 e-mail  
 7 from R. Mullen to A. Hurst. Two days later, Oracle accepted Google’s invitation and propounded  
 8 Interrogatory 40 requesting that Google identify all factual bases for Google’s fair use defense.  
 9 As discussed during the Hearing, Google’s *only* mention of OpenJDK in response is the statement  
 10 that Google’s infringement did not harm the market (fair use factor four) for the Java SE platform  
 11 because “by the time Android was released, Sun/Oracle had already enabled the fragmentation of  
 12 the Java SE platform by giving away the SSO for free, and without any restrictions on  
 13 fragmentation, through OpenJDK and the associated GPLv.2 with the Classpath Exception open  
 14 source license, which does not require compatibility.” ECF No. 1563-22 (Ex. 21) at 13. Google  
 15 now argues that because the interrogatory sought factual bases of fair use, it was not required to  
 16 disclose anything about its new theories.<sup>2</sup> But just as Google included the “factual bases” of its  
 17 fragmentation theory, so too was it required to disclose the others. Google’s new factor 2 theory  
 18 is predicated on Sun publishing OpenJDK declaring code and SSO. Its new factor 4 theory  
 19 requires “facts” that Sun’s release of OpenJDK diminished licensing revenues for Java SE. And  
 20 Google’s “consent” argument required disclosure of “facts” that Sun’s release of a licensed  
 21 version of its copyrighted work was somehow consent for others to copy it without regard to any  
 22 license. Those “factual bases” should have been disclosed, along with fragmentation, in Google’s  
 23

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24 the sale or licensing of Android-compatible devices, applications, developer access to Google  
 25 resources or accounts, and Google mobile search, location services, advertising, and other  
 26 services (in addition to other Android-related revenue and profit streams obtained by third-  
 27 party application developers, device manufacturers and others); (2) the fact that Google has  
 28 realized substantial revenue as a result of the infringement, including improved long-term  
 business prospects in many other lines of business. . .

<sup>2</sup> Google’s new OpenJDK-related fair use arguments are that: (1) OpenJDK is relevant to factor two because it was published; (2) Oracle “consented” to Google’s infringement by releasing OpenJDK; and (3) OpenJDK caused a reduction in Oracle’s licensing revenues for Java SE.

1 interrogatory response.<sup>3</sup>

2 During the Hearing, Google suggested that the parties' discovery agreement excused  
3 Google from disclosing all of its OpenJDK-related fair use arguments. This is wrong. First, the  
4 language that Google included in its discovery response and read to the Court during the Hearing  
5 does not meet the parties' agreement to disclose "categories of information:"

6 In support of this contention, Google reserves its right to rely upon, and  
7 hereby incorporates by reference, all facts set forth in the previous trial  
8 record in this matter, including all trial transcripts and trial exhibits, any  
deposition testimony and exhibits preceding the previous trial, and any  
briefing, or exhibits identified in briefing, preceding the previous trial.

9 *Id.* at 15.<sup>4</sup> Second, even if it were somehow proper to make a wholesale reference to the entire  
10 prior record, Google's new OpenJDK fair use theories were not disclosed in the first trial.  
11 Google never argued during or before the prior trial that OpenJDK's publication was relevant to  
12 fair use factor 2, never argued that OpenJDK decreased the market for Java SE, and never argued  
13 that OpenJDK was evidence of Oracle's "consent" to Google's infringement. (Google also never  
14 disclosed OpenJDK as a noninfringing alternative prior to November 2015). To the contrary,  
15 Google expressly disclaimed any express license defense and the Court rejected Google's implied  
16 license defense. ECF Nos. 1203 and 1456.

17 Simply because "evidence of OpenJDK [] came into the first trial," Google Supp. Br. at 4,  
18 did not put Oracle on notice that Google intended to rely on OpenJDK for anything and  
19 everything that could conceivably be claimed to be related to fair use. Oracle propounded a fair  
20 use interrogatory precisely so it would know the bases for Google's claim of a defense to fair use,  
21 and Google's only reference to OpenJDK related to fragmentation. Google did not identify any  
22 "categories of information" related to OpenJDK, as required by the parties' agreement, sufficient  
23

24 <sup>3</sup> Google's response shows that it knew it had to disclose its theories and facts on which such  
25 theories were based, regardless of whether those theories or facts were disclosed during the first  
26 trial. For example, Google response to Interrogatory No. 40 states that its "use of the SSO was  
27 also a fair use because the purpose of Google's use of the SSO was to achieve interoperability"  
and that "the SSO reflects only 37 of the 166 Java API packages in the asserted copyrighted  
works," even though those were facts adduced during the first trial.

28 <sup>4</sup> Google cites similar introduction language in one of Oracle's interrogatory responses, but  
ignores the *nine pages* of theories and facts that follow that language. Google Supp. Br. at 4.

1 to disclose its new theories.

2 Google argues that its generic reference to “Sun’s licensing practices” was sufficient  
3 disclosure of its specific OpenJDK arguments. *Id.* at 1. This is the exact type of “hide the ball”  
4 tactic that the Court warned the parties against engaging in at the beginning of this case. ECF No.  
5 110 at 7:5-20. And though Google’s argument is specifically about OpenJDK and Interrogatory  
6 No. 40, the logic of its argument and its gloss on the parties’ agreement would apply across all  
7 interrogatories (for both parties), meaning that both parties would be free to present all sorts of  
8 theories at trial that were undisclosed during the most recent phase of discovery. This would turn  
9 “no surprises” into a trial full of them.

10 Because Google’s new OpenJDK fair use arguments were not disclosed during fact  
11 discovery or the prior case, those arguments should be excluded. Moreover, as explained in  
12 Oracle’s reply brief in support of its motion *in limine* regarding OpenJDK, Google’s new  
13 substantive arguments lack merit and would severely undermine copyright law and valuable  
14 open-source software licensing. Finally, at the Hearing, Oracle showed the Court documents and  
15 testimony refuting Google’s OpenJDK counterfactual. The three hours of argument that followed  
16 were a preview of the time consumed and jury confusion that will result if the OpenJDK  
17 counterfactual is permitted in this case.

18  
19 Dated: April 15, 2016

Respectfully submitted,

Orrick, Herrington & Sutcliffe LLP

21 By: /s/ Alyssa M. Caridis  
Alyssa M. Caridis

22  
23 Counsel for ORACLE AMERICA, INC.